

REMARKS

Claims 1-3, 12-16 and 18-64 are pending.

The Examiner has rejected claims 1-3 and 55-56 as indefinite. Although Applicant believes claim 1 to be clear as written, Applicant seeks to address the Examiner's §112 rejection by simply removing one of the changes to claim 1 from the previous amendment.

Anticipation Rejection Over Apps '874

The Examiner has rejected claims 29-31, 33-44 and 58, 59 and 64 as anticipated by Apps '874 (US 4,899,874).

Claims 29, 58, 59 and 64 recite that each of a pair of columns is substantially the same height and each extends a first height above a first location on the lower edge. Another (third) column has an uppermost surface that is coplanar with an uppermost surface of one of the plurality of pylons, and the another (third) column is a second height above a second location along the lower edge. Apps '874 does not have another (third) column that has an uppermost surface that is substantially coplanar with an uppermost surface of one of the plurality of pylons, as required by these claims.

Obviousness Rejection Over Apps '874 and Kelly and Kappel and Ex. 2

The Examiner has rejected claims 1-3, 12-16, 18-40 and 42-64 as obvious over Apps '874 in view of Kelly (Des. 371,239) and Kappel (2,970,715) and Ex. 2 from D.W. Plastics.

Claims 12-16 and 18-28

On Page 5 of the February 25, 2004 Final Rejection, the Examiner admits that these references do not disclose, alone or in combination, "at least one vertical, longitudinal recess opening upwardly and aligned with one another," as required by claims 12-16 and 18-28. Therefore, Applicant assumes that the rejection of these claims under §102 was in error. Clarification is requested.

Claims 29-31, 33-40, 42-44, 58, 59 and 64

Claims 29-31, 33-40, 42-44, 58, 59 and 64 are not obvious for the same reasons that they are not anticipated as indicated above. Based upon the Examiner's comments, Applicant understands the Examiner's position to be that all of the terms of the claims are found in the '874 reference alone. Otherwise, the Examiner has not set forth a *prima facie* argument for obviousness, e.g. identifying any differences between the claims and the prior art. Therefore, Applicant's arguments stated above are applicable and fully responsive.

Claims 1-3, 32, 41, 45-57 and 60-63

The Examiner has clarified that he is rejecting these claims in view of all four references in combination. (Final Office Action mailed February 25, 2004, page 7). The Examiner's proposed motivation for such a modification is not clear, but is not found in any of the references.

The Examiner admits that Apps '874 does not disclose the upper edge and the lower edge having a curved shape. (Final Office Action mailed February 25, 2004, page 4). The Examiner argues that it would have been obvious to have employed the "integrally molded contoured wave-shape of Kelly, Kappel and D.W. Plastics in modifying the shape of the lower wall portion . . ." However, there is no "integrally molded contoured wave-shape of Kelly, Kappel and D.W. Plastics." The Examiner finds (or presumably finds) a different contour or wave-shape in each of these references, not a single, common "integrally molded contoured wave-shape." Just as there is no single, common shape in these references, there is no motivation in any one of them for modifying Apps '874 in the manner proposed by the Examiner.

First, Kelly discloses a wave-shaped side element on the outside of a beverage container case. The side element is spaced from the exterior of the side walls of the container case. The side walls of the container are straight and level, not wave-shaped. Therefore, even if one were motivated to modify Apps '874 in view of Kelly (even though there is no evidence of motivation), the side element would be spaced from the exterior of the side walls in Apps '874, which still have straight and level upper and lower surfaces. Therefore, Kelly does not render the claims obvious.

Next, Kappel discloses a curved portion (the Examiner referring to the portion near numeral 31 in Figure 2 of Kappel) below a handle in order to accommodate insertion of a hand. Apps '874 does not include a wall portion below the handle, which is where the curved edge in Kappel is located. There is no motivation for modifying the Apps '874 crate to curve a wall to accommodate insertion of a hand because in Apps '874 it is already completely open below the handle. Viewed another way, there is nowhere to put the curved edge of Kappel in the crate of Apps '874 because there is no wall portion below the handle in Apps '874. Therefore, none of the claims are obvious over Apps '874 in view of Kappel.

The Examiner's use of Ex. 2 from D.W. Plastics is unclear. As is not disputed, the lower edge of the D.W. Plastics wall is straight, not contoured. The Board has indicated that modification according to any suggestion from D.W. Plastics would still leave the lower edge of the side wall straight. (Page 8 of Board Decision)¹. Therefore, the claims would not be obvious over Apps '874 in view of Ex. 2 from D.W. Plastics.

Claim 45 specifies that first and second locations directly opposite one another on the upper edges of the two side structural members are vertically offset. Kelly shows a wave-shaped side element spaced away from an exterior of the side walls of a container. Although there is no motivation for making the modification proposed by the Examiner, as explained above, if one were to modify Apps '874 in accordance with Kelly (even using hindsight), one would attach the wave shaped side element to the exterior of the side walls of Apps '874, still leaving Apps '874 with straight upper and lower edges. In the present invention as claimed, the wave-shape is the side structural member (for example, claim 45 further specifies that the side structural members are "defining an inner compartment with the floor structure"). Therefore, Claim 45 is patentable.

For claims 24, 25, 40 and 41, it appears that the Examiner is calling walls 29 of Apps '874 part of the columns. This is contrary to the plain and ordinary

¹ The Board Decision in the parent application, Serial No. 08/854,294, is attached herewith. It should be noted that this Decision has been referenced at least three times in the prosecution of this application. The Examiner indicated only in the last Final Office Action that "it seems bizarre that applicant refers to 'page 8 of Board Decision.'" Final Office Action mailed February 25, 2004, page 8.

meaning of the term "columns." The columns of Apps '874 are spaced away from the floor. Therefore, claims 24, 25, 40 and 41 are independently patentable.

Obviousness Rejection Over Apps '874 and Sauey

The Examiner has, in the alternative, rejected claims 24, 25, 40 and 41 as obvious over Apps '874 in view of Sauey (U.S. Patent No. 2,928,530). There is no motivation for this proposed modification to App '874. The Examiner's proposed motivation is "to prevent the contents from slipping through an opening." However, this motivation is not found in either Sauey or Apps '874. There is no reason to believe (and in fact it seems unlikely) that bottles could slip through the opening under the walls 29 of Apps '874.

Additionally, Sauey is a box for shotgun shells. One of ordinary skill in the art in beverage cases would not look to shotgun shell boxes for suggestions for modifying low-depth beverage cases. For example, Apps '874 makes provisions for making sure that the empty beverage cases will nest to reduce their stacked height because beverage cases are frequently reused. In particular, Apps '874 indicates that the purpose of the gap between the floor and columns is to accommodate stacking (and partially nesting) without having to taper the columns. (Apps '874 column 6, lines 44-52). In contrast, the shotgun shell box of Sauey cannot nest and makes no provisions for stacking empty boxes at a reduced stacking height. It would be contrary to the stated purpose in Apps '874 to extend the columns down to the floor, as this would interfere with stacking the empty cases at a reduced height without tapering the columns. Therefore, claims 24, 25, 40 and 41 are independently patentable.

Even if Apps '874 were so modified in accordance with Sauey, the columns would not extend down below the lower edge of the side structure as required by claims 25 and 40. The columns in Sauey do not extend below the sidewalls.

Double-Patenting Rejections

The Examiner has not set forth a *prima facie* case of double-patenting. The fact that these claims contain some common subject matter as some claims in other patents and patent applications is insufficient. The particular "common subject

matter" recited by the Examiner in this case is "A stackable low depth case comprising side walls, end walls, bottom, pylons and columns" -- features that are also found in the prior art.

The Examiner does not present a *prima facie* case of double-patenting for any of the 46 pending claims, despite the vast number (71) of pending and issued claims upon which the Examiner bases the rejections. Left to guess, Applicant would have to compare each of the 46 to each of the 71 co-pending and issued claims, giving 3,266 possible rejections that the Examiner may or may not be making here. Clarification of which of the co-pending and issued claims are applied to which of the present claims is requested.

The Examiner *has* clarified that he is not making an obviousness-type double-patenting rejection. (Page 8 of Final Rejection mailed February 25, 2004). Rather, the Examiner cites *In re Schneller*. That case describes a *rare* type of double-patenting rejection (MPEP 804 (II)(B)(2)) and is not applicable here.

Further, "approval of the [Examiner's SPE and] TC Director must be obtained before such a nonstatutory double-patenting rejection can be made." There is no indication that such approval was obtained here. Therefore, for this additional reason, the double-patenting rejections should be withdrawn.

It should be noted in particular that the Examiner is making an *In re Schneller* type double-patenting rejection of these utility claims over a design patent. Double-patenting rejections between utility and design applications are rare, as are *In re Schneller* type double patenting rejections. The fact scenario of *In re Schneller*, to which the case is limited, requires the rejection of utility claims over other utility claims. Thus an *In re Schneller* type double patenting rejection of a utility application over a design patent would seem logically impossible.

CONCLUSION

Reconsideration is requested. It is believed that no fees are due; however, if any additional fees are due, please charge Deposit Account No. 50-1984.

Respectfully submitted,

Date: April 26, 2004


Konstantine J. Diamond
Registration No. 39,657
4010 East 26th Street
Los Angeles, California 90023
Telephone: (323) 262-5145
Facsimile: (323) 269-8506

Attachment: Board Decision, 08/854,294 (16 pages)